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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/184,600	11/02/98	SITRICK	D STD-1716

EXAMINER	
SAGER, M	
ART UNIT	**PAPER NUMBER**
3713	8

QM12/1122

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DATE MAILED: 11/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/184,600	Sitrick
Examiner	**Group Art Unit**
Sager	3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on Aug 9, 1999; Aug 23, 1999 and Nov 15, 1999.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-71 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 40-41, 44-45 and 48-49 is/are allowed.

☒ Claim(s) 1-30, 32-39, 42-43, 46-47 and 50-71 is/are rejected.

☒ Claim(s) 31 and 50 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

MARK SAGER
PRIMARY EXAMINER Part of Paper No. _____

Priority

1. The application was filed as a division of prior parent application no. 08/645,678; however, there was no restriction or election of species in cited parent application. Thus, the application is not a division application, but may be a continuation application. If priority is desired to be claimed, examiner suggests amending specification at line 1 to state this application is a continuation, if determined as appropriate, of above cited parent which is now patent 5,830,065.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 'mapping of the poses... emotional function' (clm 31) and the means for the users image from the secondary source to 'participate with predefined associative actions in the presentation as an extra actor' (clms 40-41, 44-45 and 48-50) must be shown or the feature(s) canceled from the claim(s). Particularly for claims 40-41, 44-45 and 48-50, there is a lack of illustration in the drawings for the participating as an extra actor. No new matter should be entered.

Specification

3. The amendment filed Nov. 15, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: movie projector and light projector (clms 59

and 69); movie theater (clms 62 and 64), and; film stock, computer tape and storage array (clms 66 and 70). Applicant is required to cancel the new matter in the reply to this Office action.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: 'default' (clm 10), 'positional and temporal' characteristics (clm 15-16, 18) and 'time and spatial' data (clm 22) and further, 'mapping of the poses... emotional function' do not appear to have proper antecedent basis.

Claim Objections

5. Claim 11 is objected to because of the following informalities: use of acronyms DVD and CD-ROM. The definitions of these acronyms are generally known in current use; however, examiner is noting that definitions of these acronyms may change over time which could thus change the scope of claims as a result. Further, the use of term 'modem' appears inconsistent with other memory media listed. Examiner requests applicant to provide explanation of equivalence of modem as a source in the claimed listing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The 'the background scene, a sequence of background scenes' (clm 25) is confusing

and inconsistent with ancillary data as described in specification and acknowledged by applicant during telephonic interview.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Applicant is advised that should claim 44 be found allowable, claim 50 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

10. Claims 1, 5-6, 8, 11 and 38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Breslow et al (4,710,873). Breslow discloses a game clearly teaching claimed invention (figs. 1-8, esp. 4a-4e), as broadly claimed.

11. Claims 1, 5-9, 11-16, 18, 21-23, 29-30, 34-39, 42-43, 46-47, 51-61, 63 and 65-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Bloch et al (4,688,105). Bloch discloses a video recording system teaching integrating a user's image into an audiovisual presentation where the user's image is present in some and absent in other scenes thereby requiring timing

synchronization with presentation which may be a manual time code or other known timing techniques for input of user's image (3:41-4:2; 4:43-45; 4:58-5:6; 5:37-56; 6:10-7:3; 7:48-10:61; 11:22-31; 12:8-13:8; 14:20-26, figs. 1-15).

12. Claims 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Spackova et al (4,539,585). Spackova discloses a video presentation method or system (2:35-45; 3:67-5:9, figs. 1-3, esp. 3) comprising steps/features for providing digitized image data (77), providing ancillary data (85', 86, 86' and 86), selecting one of a plurality of image integration options (4:24-28, refs. 81-83, 85, 86, 85', 86'), integrating the respective ancillary data to the selected integration option and providing the visual display presentation (4:29-51), as claimed.

13. Claims 32-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sato (4,858,930). Sato discloses a game system clearly teaching claimed features, as broadly claimed.

Claim Rejections - 35 USC § 103

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Breslow et al. in view of Sitrick ('014 or '509). Breslow discloses a game system as a video entertainment apparatus comprising claimed features (supra) except a default and means for selecting a presentation type. Sitrick discloses a game apparatus teaching a default and means for selecting a presentation type between a default and integrated presentation game mode (fig. 1b, refs 105, 110) for user enjoyment to permit a user the option to integrate an image or to play a default game which does not integrate an image. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'default' and means for selecting... a presentation type' as taught by Sitrick to Breslow's game for user enjoyment by

allowing a user the option to either integrate an image into game play or to play a default game without image integration.

15. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Breslow et al or Bloch et al . Breslow and Bloch each disclose a system for incorporating a user's image into an audiovisual presentation including focusing and zooming capability for camera adjustment (supra) but each fails to disclose scaling the images so as to provides for the resizing or formatting. Resizing and formatting techniques are very well known in imaging and photography arts for improving images being processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add scaling for resizing and formatting to either Breslow's or Bloch's system to improve the images being processed.

16. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al in view of Spackova et al. Bloch discloses a system comprising claimed features (supra) except 'texture map' (clm 17) and 'parameter data, ... texture wrapping... characters' (clm 19). Spackova discloses a previewer which suggests using a 'texture map' and parameter data, ... texture wrapping... characters' (2:35-45; 3:67-5:9, figs. 1-3, esp. 3) so articles may be dynamically as well as statically viewed in relation to the context of their use (1:6-9; 1:44-2:21; 2:35-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'texture map' and 'parameter data... characters' as suggested by Spackova to Bloch's recording system so articles may be dynamically as well as statically viewed in relation to the context of their use.

17. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breslow et al. Breslow discloses a game system for user creation and storage of image signals including focusing apparatus (2:38-12:46, figs. 1-8) comprising an apparatus for generating user image signals for at least one of a plurality of poses (3:27-35, figs. 1 and 5-7), storage apparatus (120), wherein user image signals... the defined index structure (figs. 5-7, ref. 120) wherein the plurality of poses are different poses or facial expressions (11:20-30, fig. 4, esp. 4e), but fails to clearly disclose an 'apparatus for formatting the user image signals'. Resizing and formatting techniques and apparatus are very well known in imaging and photography arts for improving images being processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an 'apparatus for formatting the user image signals' to Breslow's system to improve the images being processed.

18. Claims 20, 62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloch et al. Bloch discloses a system comprising claimed features (supra) except 'derived from' (clm 20) and 'movie theater' (clms 62 and 64). Regarding claim 20, the difference between that which is claimed and that clearly taught by Bloch lies in where the positional and temporal signals are provided by a user manually or derived automatically by the system. Making Bloch's system automatic so as to derive from the display signals the positional and temporal characteristics of Bloch's recording system is an obvious improvement for reducing human error.

Regarding claims 62 and 64, the displaying the user recorded images being located at or in a movie theater is an equivalent to the displaying/viewing of the recorded images disclosed/taught by Bloch. Thus, the location being a 'movie theater' does not patentably distinguish.

Allowable Subject Matter

19. Claims 40-41, 44-45 and 48-49 are allowed.

20. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

21. Claim 50 contains patentable matter; however, it is objected to as being a substantial duplicate of claim 44 as stated above.

22. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Response to Arguments

23. Applicant's arguments with respect to claims 1-30, 34-39, 42-43, 46-47 and 51-71 have been considered but are moot in view of the new ground(s) of rejection.

24. Applicant's arguments for claims 32-33, filed Aug. 23, 1999 have been fully considered but they are not persuasive. Sato clearly shows every feature as broadly claimed. Examiner notes during telephone discussion with applicant as having directed applicant to breadth of claims fails to preclude Sato's teachings from anticipating claimed invention.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato shows texture mapping and Masuda shows method and machine for trying on a hairstyle.

26. This action is not made final in order for applicants to respond to new issues raised herein.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms.Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148 or (703) 305-5648.

M. Sager
Primary Examiner
Oct. 31, 2000

ATTACHMENT TO AND MODIFICATION OF NOTICE OF ALLOWABILITY (PTO-37)

(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored[1]:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

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[1] The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "*Changes to Implement the Patent Business Goals*", 65 *Fed. Reg.* 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 99, 110, 135, 139 (September 19, 2000).